

### **REMARKS**

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-28 are presently pending before the Office. No claims have been canceled. Applicant has amended the claims. No new matter has been added. Claims 24-28 have been allowed. Claims 15-19 have been objected to, but would be allowable if rewritten in independent form. The rewritten claims are re-presented as claims 29-33. Claims 1-14 and 20-23 have been rejected. The claims have been rewritten herein. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

### **§132**

Relying on 35 U.S.C. §132, the Examiner has required the cancellation of the additions to the claim language added in the Amendment filed 6/25/2003 regarding material regarding “supports terminating in one or more aligning straight-ended members” as being new matter which is not supported by the original disclosure. Applicant respectfully traverses the rejection and requests reconsideration.

As stated by the Circuit Court of Patent Appeals, “‘New matter’ is a technical legal term in patent law – a term of art. Its meaning has never been clearly defined for it cannot be.... We have to decide on a case-by-case basis what changes are prohibited as ‘new matter’ and what changes are not.” In re Oda, 170 USPQ 268, 270-71 (C.C.P.A. 1971). An applicant is permitted to amend an application to include features of the claims or drawings to enhance the clarity of the application. This is especially true where the need for clarification is based upon the

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requirements of the Examiner. Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1303-1304 (Fed. Cir. 2003).

The fundamental inquiry is whether the material added by amendment was inherently contained in the original application. Schering Corp. v. Amgen Inc., 222 F.3d 1347, 1352 (Fed. Cir. 2000). "To avoid the new matter prohibition, an applicant must show that its original application supports the amended matter." Id.

It is respectfully submitted that the added description fully complies with 35 U.S.C. §132. The description and drawings properly described the element added in the amendment.

As explicitly stated in the amended specification, at line 20 of page 10, "A footer 30 is provided, comprising core holes 32 complementary to the extensions 28 below the panel 10." The application continues on Page 11: "It may also be preferable to lay a bed of grout between the rod holes in the footer 30 to create a seal between the panel 10 and the footer 30." Further on Page 11, "The panel 10 is then placed on the footer 30 so that the extensions 28 are located in the core holes 32 of the footer 30." As shown in Figures 3 and 4, the extension 28 fits into the holes 32. Since these are rod holes, the logical conclusion is that the holes are for rods and that the element 28 is a rod. Furthermore, element 28 is more clearly a rod by the way it extends below the panel in Figure 1. Since element 28 is an extension from the interior support of a panel, and it is a vertical element from both the front and side views, it is a support terminating in one or more straight-ended rod members" as described in Claim 1, as currently amended. Therefore, no new matter has been added to the application. Also, no estoppel should apply to this amendment. Withdrawal of the objection is respectfully requested.

§112

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Relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of Claims 1-11 and 20-23 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner alleges that it is unclear in claim 1 whether the means for reinforcing the supports or the supports themselves are terminating in one or more aligning straight end members. The Examiner also states that claim 20 is unclear whether the panels are claimed in combination with the insert. Applicant respectfully traverses the rejection and request reconsideration.

Applicant submits that claims 1 and 20 do define the legal metes and bounds of the invention. It is the role of the claims merely to define, for those skilled in the art, the legal metes and bounds of the invention. Applicant asserts that the claims as filed fulfill their function. Nevertheless, in order to advance the case to allowance, claims 1 and 20 have been amended to and to clarify the elements of the claims.

It is respectfully submitted that the claims, as amended, fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

#### §102

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 1-3, 5 and 9 as being anticipated by WALLIN. Applicant respectfully traverses the rejection and request reconsideration.

Applicant respectfully submits that it is important to note that the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

Unlike WALLIN, the claims in the present application, as amended, include rod-shaped structures extending below the panel. The fact that the structures are rods used for strengthening the panel make them uniquely suited for reinforcement as they become part of the one-piece footer, when installed. Furthermore, when the rod is bonded to the footer, the connection creates a synergistic effect to significantly strengthen the wall.

WALLIN does not teach or suggest these structures. WALLIN discloses extensions which explicitly terminate in protrusions with hooked ends. See Col. 4, l. 5-9. These protrusions could not fit in the voids of the present invention. Furthermore, the hooked ends in WALLIN are designed to interact with a horizontal reinforcing bar 24, as shown in Figures 11 and 16. This hook and horizontal reinforcement bar arrangement is an expensive and labor intensive assembly which teaches away from an arrangement with generally vertical extensions, as referenced in the amended claims. The horizontal bar is located in a trough I the footing 9 which is then filled with cementous material. Moreover, since the horizontal bar 24 is embedded in cementous material (Col. 4, l. 51-54), there is no ability for the wall to be welded to the footer, as found in the present claims, as amended.

The differences between WALLIN's embodiment having a flange was discussed in the previous amendment and need not be reasserted here. Moreover, WALLIN does not disclose or suggest a one piece footer. The footings 9 in WALLIN are taught to rest on pads 21 (Col. 4, l. 27-29). The pads 21 are clearly separate elements that are optionally interlocking. (Col. 4, l. 34-38). The pads 21 and not the footings 9 rest on aggregate for stability (Col. 4, l. 27-29). Thus a two-element foundation is taught in WALLIN, and a single element footer, as detailed in the amended claims, is neither suggested nor described. Unlike the present invention, the WALLIN

arrangement is suited for a retaining wall instead of a wall for a free standing structure. This is illustrated

Accordingly, each and every element of Applicants' claims has not been taught in that single reference. In other words, the rejected claims do not read literally on any single item of prior art because WALLIN does not teach, disclose or suggest the straight rod adapted for welding as stated in the presently amended claims. Precise voids corresponding to the straight ends coming out of the bottom walls is not taught, disclosed or suggested in WALLIN or any other prior art. In addition, WALLIN does not teach, disclose or suggest a rod coming out of the end of the panel that is adapted for welding. Accordingly, Applicant respectfully submit that claims 1-3, 5 and 9 have not been anticipated by the WALLIN patent under 35 U.S.C. §102(b), and respectfully request that such rejection be withdrawn.

Also, Examiner has rejected claims 20-23 as being anticipated by CARTER et al. Applicant understands Examiner's statement that CARTER teaches the use of a member between slabs that will be tilt-up walls. However, CARTER, like HARRIS, teaches the creation of at least two adjacent slabs to be created horizontally and erected simultaneously.

It is important to note that the control joint 400 described in CARTER is not shown in the patent drawings at all. Thus, CARTER is not an adequately teaching reference at all. However, even if it were a valid reference, the present invention, as found in the amended claims, clearly teaches an invention with limitations and elements not found in CARTER.

CARTER teaches slabs poured so that ribs of the inserts are interlocking with the walls. Thus, the inserts are set while the slabs are liquid. This element is entirely contrary to the present

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invention, and in fact teaches away from the present invention's inserts for use after at least one slab has been erected.

Also, CARTER teaches interlocking members with a detachable cap 475, and a base 412 neither of which are part of the present invention. The amended claims include a unitary insert, which is used after at least one wall has been erected. This element is not taught, described or suggested in CARTER. Moreover, since CARTER teaches pouring slabs around the insert, it teaches away from the present invention. Accordingly, Applicant respectfully submit that claims 20-23 have not been anticipated, and respectfully request that such rejection be withdrawn.

### §103

The Examiner's rejection of claims 4,6-8 and 11 under 35 U.S.C. §103(a) as being unpatentable over WALLIN is respectfully traversed for the reasons discussed above.

In addition, the "means plus function" limitation should be interpreted in a manner consistent with the specification disclosure. If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning. If no definition is provided, some judgment must be exercised in determining the scope of the limitation. MPEP §2182. The "means for" claim language, in view of the specification, properly defines the invention without having to introduce limiting language to distinguish it from art having separate structure. Nonetheless, in order to bring this case to allowance, the rejections to the claims having this language are respectfully traversed.

In the present application, the details of the reinforcing bar and the placement of means for facilitating placement of the panels are optimized for a particular purpose and using structure which was not contemplated in WALLIN. As stated above, WALLIN was a reference depicting a retaining wall. The details in the present patent are optimized for use in forming block-outs for conduit within a structure. Consideration for this purpose would never be made in making design choices in practicing the WALLIN patent, which is a retaining wall. Therefore, this rejection is respectfully traversed.

Also, Examiner's rejection of claims 12 and 13 over WALLIN in view of HARRIS is respectfully traversed. HARRIS is not analogous art in that it teaches the creation and placement of several panels simultaneously. Furthermore, HARRIS teaches a rope seal 112 created between concrete panels instead of an insert added after at least one wall has been raised. A rope seal 112 extends longitudinally and is a labor intensive device which is difficult to use in the field. Moreover, the rope seal as taught is actually a spacer used between two horizontal concrete panels before it is raised. Thus, since a plurality of panels is raised in HARRIS, it requires a large amount of room at a work station on site which is not required in the present invention according to the amended claims. Furthermore, HARRIS requires the use of a forklift in operation, which requires a path as well as a specially trained operator that would not be contemplated in the present invention, as found in the amended claims.

Accordingly, the Examiner has not established a prima facie case of obviousness. A finding by the Office that a claimed composition would have been obvious to one of ordinary skill in the art at the time the invention was made based merely upon finding similar elements in a prior art reference would be "contrary to statute and would defeat the congressional purpose in

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enacting Title 35." Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593 at 1605 (Fed. Cir. 1987). Applicant respectfully submits that claims 4, 6-8, and 11 are patentable over the cited patents under 35 U.S.C. §103. Withdrawal of the rejection is respectfully requested.

Claims 24-28 have been allowed, and claims 15-19 would be allowable if rewritten. These claims are re-presented in claims 29-33. It is respectfully submitted that all claims, as amended, are now in condition for allowance. The Examiner's objections to the amendment filed 6/25/2003 have been traversed. The Examiner's §112 rejections have likewise been addressed. The remarks and the amendments to the claims respectfully traverse the rejections made. Since the amendments herein merely clarify the language of the specification and the claims, and no additional limitations have been made, no estoppel applies to these amendments.

It is believed that the application is now ready to be passed to issue.

Respectfully submitted,



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